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No. 91-1672

In the Supreme Court

OF THE

United States

OCTOBER TERM, 1992

BIODEX CORPORATION,
Petitioner,
v.
LOREDAN BIOMEDICAL, INC., et al.,
Respondents.

On Petition For A Writ Of Certiorari To The United States Court of Appeals For The Federal Circuit

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Whether the Federal Circuit's decision that appellate review of the sufficiency of the evidence supporting a jury verdict in a patent trial is barred where the appellant made no post-trial motions conflicts with Supreme Court precedent.

2. Whether the Federal Circuit's decision that appellate review of the sufficiency of the evidence supporting a jury verdict in a patent trial is barred where the appellant made no post-trial motions creates a split among the United States Circuit Courts of Appeal which requires Supreme Court resolution.

3. Whether the Federal Circuit exceeded its jurisdiction in applying its own law instead of regional circuit law in determining that appellate review of the sufficiency of the evidence supporting a jury verdict in a patent trial is barred where no post-trial motions are made.

PARTIES TO THE PROCEEDING BELOW

The parties to the proceeding below were as follows: Petitioner Biodex Corporation was the appellant in the Federal Circuit Court of Appeals and the plaintiff in the United States District Court. Respondents Loredan Corporation* and Malcolm L. Bond were the appellees in the Federal Circuit Court of Appeals and the defendants in the United States District Court.

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* Pursuant to Supreme Court Rule 29.1, Loredan Corporation reports that it has no parent company, subsidiaries or affiliates.

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BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

STATEMENT OF THE CASE

Biodex Corporation ("Biodex") is the assignee of two patents in suit—U.S. Letters Patent No. 4,628,910 (the " '910 patent"), issued December 16, 1986 and U.S. Letters Patent No. 4,691,694 (the " '694 patent"), issued September 9, 1987. Biodex sued Loredan Biomedical, Inc. and Malcolm Bond, Loredan's founder, (collectively "Loredan"), asserting that Loredan's LIDO® Active machine infringed both patents.

At trial, the jury found that the '694 patent was invalid under 35 U.S.C. § 102(b) because the subject matter of the claimed invention had been offered for sale in the spring and summer of 1985, more than one year before the effective filing date of the application leading to the '694 patent. The jury also found that the LIDO® Active did not infringe the '910 patent, either literally or under the Doctrine of Equivalents.

During the trial, Biodex orally moved for a directed verdict. That motion was taken under submission and never resolved directly. After the verdict, Biodex requested and received an extension of time to file a motion for judgment notwithstanding the verdict ("JNOV"). Despite this extension, Biodex filed no post-trial motions.

Biodex appealed the jury's verdict, contending that (1) the jury verdicts were not supported by substantial evidence and (2) the jury instructions regarding infringement were erroneous. A panel of the Federal Circuit Court of Appeals affirmed. *Biodex Corp. v. Loredan Biomedical, Inc.*, 946 F.2d 850 (Fed. Cir. 1991).

The *Biodex* court held that Biodex' failure to make a post-trial motion precluded it from seeking appellate review of the jury verdicts for sufficiency of the evidence. *Id.* at 862. In reaching this holding, the *Biodex* court determined that Federal Circuit law, not regional circuit law, should control this issue because it "bears an essential relationship to matters committed to our exclusive control by statute, the appellate review of patent trials." *Id.* at 858-59.[1]

Biodex sought rehearing by the merits panel, which was denied on December 20, 1991. Biodex' suggestion of rehearing by the Federal Circuit *in banc* was declined on January 30, 1992. Biodex now seeks a writ of certiorari on the following grounds: (1) that the *Biodex* court's decision conflicts with Supreme Court precedent; (2) that the *Biodex* court's decision creates a split among the circuit courts of appeal requiring Supreme Court resolution; and (3) that the *Biodex* court somehow exceeded its jurisdiction by applying Federal Circuit law instead of regional circuit law to this issue. Biodex Petition at 4-5.

Biodex' attempt to convert this case from one which involves the narrow issues of standard of review and choice of law to one requiring Supreme Court review must fail. Despite Biodex' contention to the contrary, the *Biodex* court's opinion does not conflict with—and is in fact consistent with—Supreme Court

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[1] The *Biodex* court also held that the jury instructions were proper, a finding Biodex does not dispute here.

precedent. Further, the *Biodex* court's decision does not create a split among the circuit courts of appeal requiring Supreme Court resolution. Moreover, the Federal Circuit's decision to apply Federal Circuit law to this issue is not only fully within its jurisdiction, as set out in its enabling legislation, but also promotes the goals set out in the enabling legislation. Accordingly, Biodex' petition should be denied.

REASONS FOR DENYING THE PETITION

I

THE *BIODEX* COURT'S HOLDING THAT BIODEX' FAILURE TO MAKE A POST-TRIAL MOTION PRECLUDES IT FROM SEEKING APPELLATE REVIEW OF THE SUFFICIENCY OF THE EVIDENCE IS NOT IN CONFLICT WITH SUPREME COURT PRECEDENT

The *Biodex* court held that Biodex' failure to make a post-trial motion precluded it from seeking appellate review of the sufficiency of the evidence supporting the jury verdicts in this case. *Biodex*, 946 F.2d at 862. The *Biodex* court determined that such a rule promoted judicial economy, provided the district court a chance to correct any mistakes and was fair to litigants. *Id.* at 859-62.

Biodex' petition is based in part on its assertion that the *Biodex* decision "is directly in conflict with" this Court's decisions in *Cone v. West Virginia Pulp & Paper Co.*, 330 U.S. 212, 67 S. Ct. 752 (1947) and *Globe Liquor Co. v. San Ramon*, 332 U.S. 571, 68 S. Ct. 246 (1948). Biodex Petition at 5, 10.[2] However, Biodex' two-paragraph description of these two cases (Biodex Petition at

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[2] Although not cited by Biodex, the relevant standard for obtaining review by this Court pursuant to writ of certiorari is whether the *Biodex* court "has decided a federal question in a way that conflicts with applicable decisions of this Court." Supreme Court Rule 10.1(c). Moreover, "there must be a real or intolerable conflict on the same matter of law or fact, not merely an inconsistency in dicta or in the general principles utilized." Stern, Gressman & Shapiro, *Supreme Court Practice*, § 4.3, at 196 (1986).

5-6) nowhere identifies how the *Biodex* decision "conflicts" with either *Cone* or *Globe Liquor*. There is no such conflict.

Both *Cone* and *Globe Liquor* addressed only the *remedy* available when a party fails to move for JNOV. They did not address what standard of review should be used to determine whether such a remedy is, in fact, warranted because of an error in the trial. As such, they were properly cited by the *Biodex* court for the proposition that "the only available remedy *upon finding error* in a judgment entered on a jury verdict where there has been no motion for JNOV is limited to a remand for a new trial." *Biodex*, 946 F.2d at 854 (emphasis added).

In *Cone*, this Court granted certiorari to decide a very limited question: "[W]hether a party's failure to make a motion in the District Court for judgment notwithstanding the verdict, as permitted in Rule 50(b), precludes an appellate court from directing entry of such a judgment." *Cone*, 330 U.S. at 215. The Court acknowledged that other issues had been presented but refused to address them. *Id.* Consequently, the Court stated that "we accept, without approving or disapproving, the Circuit Court of Appeals' holding that there was prejudicial error in the admission of evidence and in the submission of the case to the jury." *Id.* Therefore, the issue of what standard an appellate court should use to determine *whether* error occurred in a jury trial when no JNOV motion was made, including whether there was sufficient evidence to support the verdict, was never presented to—let alone decided by—the *Cone* court.

Ultimately, this Court in *Cone* held that an appellate court is without power to direct the district court to enter judgment for a party who did not move for a JNOV. *Id.* at 218. It is this holding that was at issue in *Globe Liquor*, the other Supreme Court case cited by Biodex. In *Globe Liquor*, the Court granted certiorari to consider "the apparent inconsistency between" the *Cone* decision and the appellate court's order to enter judgment for an appellant who made no JNOV motion. 332 U.S. at 572. Like *Cone*, *Globe Liquor* did not address what standard the appellate court should use to determine *if* error occurred in the district court sufficient to justify a new trial.

In both of these cases, the Court limited its inquiry to the scope of the remedy available to an appellate court to correct error. Neither case addressed the appropriate standard to determine that error. Thus, neither *Cone* nor *Globe* dealt with the issue presented to the Federal Circuit in this case: whether an appellate court may determine if a jury verdict is supported by substantial evidence when the appellant failed to make any post-trial motions.

Far from conflicting with the *Biodex* court's decision, *Cone* and *Globe Liquor* highlight the importance of requiring litigants to make post-trial motions so that district courts can, in the first instance, decide whether error occurred in the trial. "Determination of whether a new trial should be granted or a judgment entered under Rule 50(b) calls for the judgment in the first instance of the judge who saw and heard the witnesses and has the feel of the case which no appellate transcript can impart." *Cone*, 330 U.S. at 216. *See also Globe Liquor*, 332 U.S. at 573 ("[T]he very circumstances which arose in this case emphasize the importance of having the District Court first pass upon whether its error should result in a new trial or in a judgment finally ending the controversy"); *Johnson v. New York, N.H. & H.R. Co.*, 344 U.S. 48, 53, 73 S. Ct. 125 (1952) ("This requirement of a timely application for judgment after the verdict is not an idle motion"). Therefore, the *Biodex* court's adoption of the rule barring review of the sufficiency of the evidence supporting jury verdicts where no post-trial motions have been made does not "conflict" with—and is in fact entirely consistent with—Supreme Court precedent.

II

THE *BIODEX* COURT'S DECISION TO BAR REVIEW OF THE SUFFICIENCY OF THE EVIDENCE SUPPORTING JURY VERDICTS WHERE NO POST-TRIAL MOTION IS MADE DOES NOT CREATE A CIRCUIT SPLIT REQUIRING SUPREME COURT RESOLUTION

Biodex also attempts to gain Supreme Court review of the *Biodex* court's decision by arguing that it creates a conflict with decisions of other circuit courts of appeal on the issue of the availability of appellate review of jury verdicts for sufficiency of

the evidence absent a post-trial motion. Biodex Petition at 6-10. *See, e.g.*, Supreme Court Rule 10.1(a).

Loredan does not dispute that there is a split among the regional circuits on this issue. The regional circuit decisions consistent with the *Biodex* decision include the following: *Charles Jacquin Et Cie, Inc. v. Destileria Serrales, Inc.*, 921 F.2d 467, 475 (3d Cir. 1990) ("Where a party has failed to move for j.n.o.v., we will not review the sufficiency of the evidence and direct a verdict for them"); *Howard v. Kerr Glass Mfg. Co.*, 699 F.2d 330, 332 (6th Cir. 1983) (a party's "failure to move for a judgment n.o.v. precludes the appellate court from considering the sufficiency of the evidence and ordering the district court to enter a directed verdict. This Court is therefore without power to consider whether the trial court erred in denying appellant's motion for a directed verdict") (internal citations omitted); *Borger v. Yamaha Int'l Corp.*, 625 F.2d 390, 395 (2d Cir. 1980) (where party failed to move for JNOV, it "lost its right to seek appellate review of the adequacy of Borger's proof on the concluded trial"); *Woods v. Nat'l Life and Accident Ins. Co.*, 347 F.2d 760, 769 (3d Cir. 1965) (court refuses to review jury verdict for sufficiency of the evidence because a "party's failure to file a motion for judgment n.o.v. in the trial court precludes an examination of the record by that court or this court for the purpose of ascertaining whether that party was entitled to a directed verdict").

However, this split among the regional circuits does not justify review by this Court. The unique nature of the Federal Circuit renders this split irrelevant to a grant of certiorari in *this* case.[3]

This Court reviews cases involving a split in the regional circuit courts so that it can resolve that split and prevent litigants from "forum shopping" for the jurisdiction with the most favorable law. *See, e.g., Mason v. Continental Group, Inc.*, 474 U.S. 1087, 1087, 106 S. Ct. 863 (1986) (White, J. and Brennan, J. dissenting) (Justices dissenting from denial of petition for writ of certiorari

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[3] Put another way, although there is a split in the regional circuits and that split might support a petition for certiorari from a decision by one of those regional circuits, it does not support such a petition to the *Federal* Circuit.

because "differences in the rules governing access to federal court for the purpose of pressing a claim under ERISA may have the troubling effect of encouraging forum shopping by plaintiffs"). However, because of the unique rules applicable to patent cases, any conflict in the circuits *cannot* lead to forum shopping, and, thus, the reason this court reviews conflict cases is simply not applicable here.

All appeals in patent cases, wherever filed, are heard by the Federal Circuit. *See* 28 U.S.C. § 1295(a)(1). Thus, the *Biodex* decision cannot lead to forum shopping in patent cases because the location of the district court in which an action is filed does not determine which circuit court will hear the appeal. Indeed, the *Biodex* decision reduces any incentive to forum shop by refusing to apply regional circuit law to the issue of the standard of review of jury verdicts on appeal. Accordingly, review by this Court of *this* decision could not reduce forum shopping, and therefore is not justified under Supreme Court Rule 10.1(a). *Cf. Ruhlin v. New York Life Ins. Co.*, 304 U.S. 202, 205-06, 58 S. Ct. 860 (1938) (Court's original grant of certiorari was to "secure uniformity of decision," but Court later noted that, "[a]s to questions controlled by state law, however, conflict among circuits is not of itself a reason for granting a writ of certiorari").

III

THE *BIODEX* COURT'S CORRECT DECISION TO APPLY FEDERAL CIRCUIT LAW TO DETERMINE THE STANDARD APPLICABLE TO ITS REVIEW OF THE JURY VERDICTS IN THIS CASE IS WITHIN ITS JURISDICTION

Although Biodex' petition is far from clear in its exposition of this ground for review, Biodex appears to make two arguments:

(1) The Federal Circuit's enabling legislation requires the Federal Circuit to apply regional circuit law in deciding whether an appellant's failure to move for JNOV precludes appellate review of the sufficiency of the evidence; and

(2) The *Biodex* court's decision to apply Federal Circuit law to that issue rather than regional circuit law was erroneous under Federal Circuit precedent.

The first argument is both unsupported and wrong; the second argument is both wrong and not a basis for a petition for a writ of certiorari.

A. The *Biodex* Decision Does Not Exceed The Federal Circuit's Enabling Legislation

Although Biodex argues that the Federal Circuit's enabling legislation[4] somehow limits the Federal Circuit's authority to decide the choice of law issue presented here, Biodex' petition nowhere sets forth any understandable basis for this contention. The most that Biodex offers is that " 'one of the primary objectives of [the Federal Circuit's] enabling legislation is to bring about uniformity in the area of patent law,' " (Biodex Petition at 11, quoting *Panduit Corp. v. All States Plastic Mfg. Co.*, 744 F.2d 1564 (Fed. Cir. 1984)), and that somehow the *Biodex* decision is inconsistent with that objective. Biodex Petition at 14.

As an initial matter, Biodex offers no authority for its implicit assertion that the Federal Circuit's enabling legislation's general objective of uniformity somehow constitutes a jurisdictional limitation such that a decision which does not promote uniformity is beyond the court's jurisdiction.

Moreover, Biodex' assertion that the Federal Circuit's decision below is inconsistent with its general mandate to increase uniformity in patent law is both unsupported and illogical. Biodex' *entire* argument on this point is as follows:

> This goal is not furthered by having a disjointed set of procedural rules in patent cases which do not concern matters unique to patent law, particularly when the procedural rules conflict with the law enunciated by the Supreme Court and several regional circuit courts.

Biodex Petition at 14.

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[4] The Federal Courts Improvement Act of 1982, Pub. L. 97-164, 96 Stat. 25, *codified at* 28 U.S.C. § 1295.

This argument makes no sense. If the Federal Circuit in *Biodex* had applied regional circuit law (as Biodex urged), there would be *less* uniformity in patent law. As the *Biodex* court noted, the application of regional circuit law would result in inconsistency because "the same patent, asserted in different district court jurisdictions, might have the same dispositive factual finding reviewed or not depending upon which of differing regional circuit laws was applicable." 946 F.2d at 859. The *Biodex* decision eliminates this problem by creating a *uniform* rule applicable to all patent cases appealed to the Federal Circuit. Therefore, the Federal Circuit's choice of law determination in this case does not even implicate—much less exceed—its enabling legislation.

B. The *Biodex* Court's Decision On The Choice Of Law Issue Was Correct And Does Not In Any Event Support A Petition For A Writ Of Certiorari

The bulk of Biodex' argument does not address the Federal Circuit's power to choose Federal Circuit law here; it merely disagrees with the result. Biodex devotes almost its entire argument to a discussion of why, under Federal Circuit precedent, the *Biodex* court should have chosen regional circuit law over Federal Circuit law. Biodex Petition at 11-14. However, Biodex can not transmogrify its disagreement with the way the Federal Circuit applies its own precedent into an issue requiring Supreme Court review. The choice of law issue here is simply not "an important question of federal law which has not been, but should be, settled by this Court." Supreme Court Rule 10.1(c).

Apart from Biodex' lack of grounds to request certiorari on this issue, the *Biodex* court's decision to apply Federal Circuit law was correct under Federal Circuit precedent. After an exhaustive review of Federal Circuit law, the *Biodex* court held that the issue of whether Biodex' failure to make a post-trial motion barred the court from reviewing the verdicts for sufficiency of the evidence should be governed by the law of the Federal Circuit instead of regional circuit law. *Biodex*, 946 F.2d at 859.

Biodex asserts that this determination is contrary to *Panduit Corp. v. All States Plastic Mfg. Co.*, 744 F.2d 1564 (Fed. Cir. 1984). Biodex argues that *Panduit* requires the Federal Circuit to

apply regional circuit law to all "procedural" issues, and that review of a JNOV motion is such a "procedural" issue.[5] However, Biodex' analysis of this choice of law issue is incomplete. What Biodex fails to grasp is that this choice of law determination, like an *Erie* problem, cannot be decided by simplistic categorizations of issues as "procedural" or "substantive."

In deciding this case, the Biodex court expressly addressed *Panduit* and many post-*Panduit* cases to define the parameters of what types of procedural issues are governed by Federal Circuit law. The court noted that there is no black and white rule to determine when an issue should be decided by Federal Circuit law. *Biodex*, 946 F.2d at 855-56. Rather, the cases present a continuum. At one extreme are cases in which the Federal Circuit applies its law to all issues in a case, whether procedural or substantive, because the court has exclusive jurisdiction over all appeals from a particular court. *See, e.g., Panduit*, 744 F.2d at 1575 (all issues in cases from Claims Court governed by Federal Circuit law). Similarly, Federal Circuit law governs all issues involving the court's determination of its own jurisdiction. *See, e.g., Sun-Tek Indus., Inc. v. Kennedy Sky Lites, Inc.*, 856 F.2d 173, 175-76 (Fed. Cir. 1988) (Federal Circuit law determines whether order increasing supersedeas bond is appealable).[6] At the other end of the spectrum are issues "totally unrelated" to patent law that are governed by regional circuit law. *See, e.g., Panduit*,

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[5] However, as the *Biodex* court noted, the law of the relevant regional circuit (the Ninth Circuit) on the issue presented was unclear at best, and was more consistent with the Federal Circuit's rule than with Biodex' position. *Biodex*, 946 F.2d at 855. *See also Kopczynski v. The Jacqueline*, 742 F.2d 555, 560 (9th Cir. 1984), *cert. denied*, 471 U.S. 1136 (1985) (in absence of JNOV motion, court refused to pass on party's contention that a directed verdict should have been entered in his favor).

[6] Biodex argues that the *Biodex* court improperly relied on *Sun-Tek* in reaching its decision because the issue of standard of review is not technically jurisdictional. Biodex Petition at 13. However, the *Biodex* court cited *Sun-Tek* merely to exemplify that not all "procedural" issues are automatically governed by regional circuit law. *Biodex*, 946 F.2d at 858.

744 F.2d at 1576 (attorney disqualification governed by regional circuit law).

The remainder of cases, like this one, fall between these two extremes. In such cases, if "the question on appeal is one involving substantive matters unique to the Federal Circuit," the court applies Federal Circuit law to "related procedural issues." *Chrysler Motors Corp. v. Auto Body Panels of Ohio, Inc.*, 908 F.2d 951, 953 (Fed. Cir. 1990). *See also Panduit*, 744 F.2d at 1575 n.14 (Federal Circuit law applies to procedural issues that are "related to patent issues"). The Federal Circuit has applied Federal Circuit law to several types of "related procedural issues." *See, e.g., Chrysler*, 908 F.2d at 953 (Federal Circuit law governs factors to be used to determine whether preliminary injunction motion should be granted in patent infringement case); *Micro Motion, Inc. v. Kane Steel Co.*, 894 F.2d 1318, 1326 n.8 (Fed. Cir. 1990) (in discovery dispute, court applies Federal Circuit law because "[a] determination of relevance implicates substantive patent law"); *Hybritech Inc. v. Abbott Lab.*, 849 F.2d 1446, 1451 n. 12 (Fed. Cir. 1988) (whether to grant preliminary injunction "involves substantive matters unique to patent law" so Federal Circuit law applies).

The *Biodex* court determined that the standard of review question presented in this case was a "related procedural issue" to be governed by Federal Circuit law. It is clear that a determination that the '694 patent was invalid under the on-sale bar created by 35 U.S.C. § 102(b) is a "substantive matter[ ] unique to the Federal Circuit." *Chrysler Motors*, 908 F.2d at 953. Thus, it seems equally clear that the standard of review for that determination is a "related procedural issue[ ]" (*id.*), which should be governed by Federal Circuit, not regional circuit, law.

As the *Biodex* court held: "Where there is an essential relationship between our exclusive statutory mandate or our functions as an appellate court and the relevant procedural issue, that relationship provides an additional reason why resolution of the procedural issue may be committed to our jurisprudence." 946 F.2d at 858. The court stated that the issue of reviewability on appeal of jury verdicts in a patent case, although not jurisdictional, bears an

essential relationship to its mandate to conduct appellate review of patent trials. *Id.* at 858-59.[7]

Finally, the *Biodex* court's reliance on Federal Circuit law instead of regional circuit law on the issue of the availability of appellate review of the sufficiency of the evidence is further justified because it promotes the objective of increasing uniformity in patent law, which is a principal purpose for the creation of the Federal Circuit. *See Panduit*, 744 F.2d at 1574 ("This court was created . . . to achieve uniformity and to reduce uncertainties" in patent law). Any other result would frustrate these goals by creating the possibility of inconsistent results with the concomitant incentive to forum shop. *See Biodex*, 946 F.2d at 859.[8]

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[7] Biodex also contends that, because regional circuit law is used to review the denial of a motion for JNOV, relying upon *Sjolund v. Musland*, 847 F.2d 1573, 1576 (Fed. Cir. 1988), regional circuit law must also be used to determine whether a jury verdict is reviewable for sufficiency of the evidence absent such a motion. Biodex Petition at 13. However, the standard used by the Federal Circuit to review the denial of a JNOV motion is unclear. *See Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 893 (Fed. Cir.), *cert. denied*, 469 U.S. 857 (1984) (applying Federal Circuit law to determine standard of review of denial of JNOV motion).

[8] For many of the same reasons, another panel—a few days before the *Biodex* opinion was issued—also applied Federal Circuit law to a "related procedural" issue. In *Foster v. Hallco Mfg. Co.*, 947 F.2d 469, 475 (Fed. Cir. 1991), the court determined that Federal Circuit law should govern the *res judicata* effect given to a consent decree holding a patent valid and infringed. After noting a split in regional circuit law on the issue, the court held that the need for uniformity and certainty in patent law required that Federal Circuit law govern. *Id.* The court also stated that applying regional circuit law would encourage forum shopping, which runs "afoul of one of the fundamental purposes for this court's creation." *Id.*

CONCLUSION

The *Biodex* court's determination that Biodex' failure to move for JNOV bars appellate review of the sufficiency of the evidence supporting the jury verdicts does not warrant this Court's review. The *Biodex* court's decision comports with Supreme Court precedent and does not create a conflict among the regional circuit courts which requires Supreme Court resolution. Moreover, the *Biodex* court's decision to apply Federal Circuit law to this issue does not exceed its jurisdiction and is not contrary to its enabling legislation. In fact, the application of Federal Circuit law to this issue promotes the goals of uniformity and certainty behind the creation of the Federal Circuit. Accordingly, Biodex' petition for a writ of certiorari should be denied.

Respectfully submitted,

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